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This familiar and useful decision is based upon a case presenting as its subject-matter a mere blacking-box. Under it an applicant may disclose two or more modifications or species of his invention, may have a generic claim as broad as the state of the art will permit, and specific claims limited to one of the species presented. He may not, however, cover in terms more than one species. While the humble invention of the case to which the decision relates sufficiently illustrates the rule thus laid down, it is to be regretted that a more complicated structure such as a machine was not involved, for in that case the decision might have gone a step further and prescribed the number of modifications an applicant might disclose as well as the number he might specifically claim. It is the purpose of this paper to call attention to the abuse of this privilege of disclosing a number of modifications and of retaining them in the case provided they can all be covered by a patentable generic claim.

The decision calls only for the elimination of inconsistent claims, and not for the cancellation of the corresponding subject-matter. There is nothing in the rules or decisions to prevent an applicant from showing, describing, and claiming, say, five complete and complicated machines, printing presses, for example, providing they constitute modifications or species of some generic invention. The claims may or may not conform to the Eagle decision; if they do, there is no requirement to be made as to the number of modifications; if they do not, a requirement for election as to the groups of specific claims is in order, but none of the modifications will be eliminated provided there be the patentable generic claim. In such a case as this, the assistant examiner

must read the specifications of five heavy machines, whereas he ought not to be compelled to read the specifications of more than two, since the genus would be sufficiently illustrated and the preferred species also disclosed.

It is believed that a considerable part of the time of the office is consumed in reading the specifications of modifications presented in excess of this number, which would be saved by an extension of the Eagle decision or by a new rule of practice which forbade this excess. It must be remembered that the descriptions of these modifications must be read (and often studied) initially whether they ultimately remain in the case or not.

A cursory examination of a single class, namely 138, Hydraulic Motors, showed twenty cases disclosing more than two modifications, each modification constituting a more or less complicated structure or machine. These cases, however, represent only the residuum of about eight years; so that the total number of such cases in that time was probably three or four times as many, or from five to ten a year. Moreover, troublesome controversies with the applicant not infrequently arise as to whether a given modification is or is not covered by the generic claim. For various reasons applicants are reluctant to cancel figures or drawings together with the corresponding descriptive matter when required to do so by the office upon the ground that they are not covered by the generic claim, and seek to retain the matter in the case by contending that the requirement is not well taken, or by contending for far-fetched, loose, or otherwise objectionable interpretations of the terms of the claim relied upon as generic. It may be remarked *obiter* that the burden, which is laid upon the Examiner, of criticising specifications and claims of applications as to their technical, literary, and legal sufficiency is one of the reasons why more progress is not made with the work.

It is said that modifications are useful as enabling the judge in an infringement suit better to appreciate that a given invention may be embodied in a variety of forms, but one additional example should be as enlightening in this respect to an intelligent judge as a dozen. Therefore it is thought that it would involve no

hardship upon applicants if they were required to limit their disclosure to two modifications at the most.

As to the authority of the Commissioner with the approval of the Secretary of the Interior to make such a rule there would appear to be little doubt. The rule would be one of expediency, and would be analogous to Rule 42, which provides for the division of an application when two or more independent inventions are presented, or to Rule 36, which requires specifications and drawings to be restricted to the invention, which means the elimination of modifications not covered by any claim. If the office under *Ex parte* Eagle may limit the number of modifications which may be specifically claimed, if under Rule 42, it may limit the number of inventions, which may be claimed in a single application, and if under Rule 36, it may require the cancellation of figures or sheets of drawings not covered by the claim, it would also appear to have authority to restrict to a reasonable number the modifications or species by which an applicant seeks to illustrate his invention.

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